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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Shawn W. O'Dowd
KENYON & KENYON
Suite 600
333 West San Carlos Street
San Jose, CA 95110

EXAMINER	
YOUNG, JOHN L	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/846,431	ROSENBERG, ARI	
	Examiner	Art Unit	
	John L Young	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 April 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

9-17-2004

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

FIRST ACTION REJECTION

(Paper#9/7/2004)

DRAWINGS

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

2. Claims 1-2 are rejected under 35 U.S.C. 101, because said claim is directed to

non-statutory subject matter.

As per claims 1-2, as drafted said claims are not limited by language within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b), even though said claims are limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75 , 47 USPQ 2d at 1602 (Fed Cir. 1998) ; *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999).

Note: it is well settled in the law that "[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims." (See MPEP 2173.05(q)).

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the

invention is not identically disclosed or described as set

> forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-27 are rejected under 35 U.S.C. §103(a) as being obvious over Horstmann US 6,285,985 (9/4/2001) [US f/d: 4/3/1998] (herein referred to as "Horstmann").

As per claim 1, Horstmann (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows "A method for the presentation of advertisements, comprising: providing exposure of an advertising message to a plurality of viewers; recording an action taken by at least one of said viewers in response to said advertising message; and providing additional exposure of said advertising message based on said action."

Horstmann lacks an explicit recitation of claim 1 even though Horstmann implicitly shows all elements and limitations of claim 1.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all the elements and

limitations of claim 1, and it would have been obvious to modify and interpret the disclosure of Horstmann cited above as implicitly showing all of the elements and limitations of claim 1, because modification and interpretation of the cited disclosure of Horstmann would have provided means to *"retrieve advertisements from an advertisement serve and to display them to the user. . . ."* (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the *"advertisements are varied to retain the interest of the user. . . ."* (See Horstmann (col. 2, ll. 5-10)).

As per claim 2, Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows "A method for the presentation of advertisements, comprising: providing exposure of an advertising message to a plurality of viewers; recording a plurality of actions taken by ones of said viewers in response to said advertising message; and providing additional exposure of said advertising message to said plurality of viewers based on said plurality of actions."

Horstmann lacks an explicit recitation of claim 2 even though Horstmann implicitly shows all elements and limitations of claim 2.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all the elements and limitations of claim 2, and it would have been obvious to modify and interpret the disclosure of Horstmann cited above as implicitly showing all of the elements and

limitations of claim 2, because modification and interpretation of the cited disclosure of Horstmann would have provided means to *"retrieve advertisements from an advertisement serve and to display them to the user. . . ."* (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the *"advertisements are varied to retain the interest of the user. . . ."* (See Horstmann (col. 2, ll. 5-10)).

As per claim 3, Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows "A method for the presentation of advertisements, comprising: providing exposure of an advertising message to a plurality of viewer computers over a computer network; recording at said server a plurality of actions entered into ones of said viewer computers, said actions made in response to said advertising message; [and] providing bonus exposure of said advertising message to said plurality of viewer computers based on said plurality of actions."

Horstmann lacks an explicit recitation of claim 2 even though Horstmann implicitly shows all elements and limitations of claim 2.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all the elements and limitations of claim 3, and it would have been obvious to modify and interpret the disclosure of Horstmann cited above as implicitly showing all of the elements and limitations of claim 3, because modification and interpretation of the cited disclosure of

Horstmann would have provided means to *"retrieve advertisements from an advertisement serve and to display them to the user. . . ."* (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the *"advertisements are varied to retain the interest of the user. . . ."* (See Horstmann (col. 2, ll. 5-10)).

As per claims 4-7, Horstmann shows the method of claim 3 and subsequent base claims depending from claim 3.

Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all elements and limitations of claims 2-7.

Horstmann lacks explicit recitation of some elements of claims 2-7, even though Horstmann implicitly shows same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 2-7 were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows the elements and limitations of claims 2-7 which are not explicitly recited in Horstman; and it would have been obvious to modify and interpret the disclosure of Horstman cited above as implicitly showing all of the elements and limitations of claims 2-7, because modification and interpretation of the cited disclosure of Horstmann would have provided means to *"retrieve advertisements from an*

advertisement serve and to display them to the user. . . ." (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the *"advertisements are varied to retain the interest of the user. . . .*" (See Horstmann (col. 2, ll. 5-10)).

Independent claim 8 is rejected for substantially the same reasons as independent claim 3.

As per claims 9-12, Horstmann shows the method of claim 8 and subsequent base claims depending from claim 8.

Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all elements and limitations of claims 9-12.

Horstmann lacks explicit recitation of some elements of claims 9-12, even though Horstmann implicitly shows same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 9-12 were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows the elements and limitations of claims 9-12 which are not explicitly recited in Horstman; and it would have been obvious to modify and interpret the disclosure of Horstman cited above as implicitly showing all of the elements and

limitations of claims 9-12, because modification and interpretation of the cited disclosure of Horstmann would have provided means to *"retrieve advertisements from an advertisement serve and to display them to the user. . . ."* (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the *"advertisements are varied to retain the interest of the user. . . ."* (See Horstmann (col. 2, ll. 5-10)).

Independent claim 13 is rejected for substantially the same reasons as independent claim 8.

As per claims 14-17, Horstmann shows the method of claim 13 and subsequent base claims depending from claim 13.

Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all elements and limitations of claims 14-17.

Horstmann lacks explicit recitation of some elements of claims 14-17, even though Horstmann implicitly shows same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 14-17 were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows the elements and limitations of claims 14-17 which are not

explicitly recited in Horstman; and it would have been obvious to modify and interpret the disclosure of Horstman cited above as implicitly showing all of the elements and limitations of claims 14-17, because modification and interpretation of the cited disclosure of Horstmann would have provided means to *"retrieve advertisements from an advertisement serve and to display them to the user. . . ."* (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the *"advertisements are varied to retain the interest of the user. . . ."* (See Horstmann (col. 2, ll. 5-10)).

Independent claim 18 is rejected for substantially the same reasons as independent claim 13.

As per claims 19-27, Horstmann shows the method of claim 18 and subsequent base claims depending from claim 18.

Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all elements and limitations of claims 19-27.

Horstmann lacks explicit recitation of some elements of claims 19-27, even though Horstmann implicitly shows same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 19-27 were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure

Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows the elements and limitations of claims 19-27 which are not explicitly recited in Horstman; and it would have been obvious to modify and interpret the disclosure of Horstman cited above as implicitly showing all of the elements and limitations of claims 19-27, because modification and interpretation of the cited disclosure of Horstmann would have provided means to *"retrieve advertisements from an advertisement serve and to display them to the user. . . ."* (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the *"advertisements are varied to retain the interest of the user. . . ."* (See Horstmann (col. 2, ll. 5-10)).

CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist

Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

John L. Young
Patent Examiner

September 7, 2004